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10/056,101	01/24/2002	Leonard Marotta	MAROTTA-ANALOG	9440

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EXAMINER

LEWIS, RALPH A

ART UNIT PAPER NUMBER

3732

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/056,101

Applicant(s)

MAROTTA, LEONARD

Examiner

Ralph A. Lewis

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 15, 18, 20, 22 and 25-41 is/are rejected.
- 7) ☒ Claim(s) 12, 14, 16, 17, 19, 21, 23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 25 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **Objections to the Drawings**

Applicant's proposed drawing correction is approved by the examiner. The drawing objection to Figures 2-2C in the earlier Office Action is withdrawn (the examiner is likewise confused by the miscellaneous reference to nonexistent Figures – apparently the language inadvertently arose in the examiner's word processor with the cut and paste of an unrelated application).

### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 27, step f, it is unclear what constitutes "conventional steps." It is unclear specifically what the "conventional steps" are, how many "conventional steps" are required of the limitation or what an "unconventional step" might be. The examiner suggests that the entire step be deleted from the claim, particularly since it is apparently just referring to prior art steps which are already known in the art.

Applicant has not responded to this rejection.

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9-11, 13, 18, 20, 25-29, 31 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlsson et al (5,125,841).

Carlsson et al disclose an anti-rotation dental analog post comprised of an elongated pin with an anti-rotation radial projection 6' extending from an end thereof. It is noted that whether the projection 6' is at the "bottom end" or "top end" depends entirely on the orientation of the dental mold, if used while taking an impression mold of the upper jaw then the radial projection would be at the "bottom end" (assuming the patient is sitting upright). In regard to claim 3, technically according to the definition of an ellipse a circle is an ellipse. In regard to claims 25 and 26, note receptacle sleeves 1, 2. In regard to claim 27, the Carlsson et al mounting pin is inserted with end 6' into an "impression spoon" (column 3, lines 30, 31)(the claimed "casting mold"), secured in place by that attachment to the spacer elements and the radial extensions 6', 6 are embedded in the impression molding material and counteract an unintentional turning of the impression top (note column 3, lines 21 and 22).

In response to the present rejections applicant argues that applicant intends for the claimed device to be used differently than the disclosed use of the prior art. It is well settled, however, that merely defining a new use for an old and known device does not make that old an known device patentable.

Claims 1-3, 9, 10, 11, 18 and 25-29 rejected under 35 U.S.C. 102(b) as being anticipated by Sutter (WO 98/52490) (note US 6,332,77 B1 is relied upon herein as an accurate translation of the PCT application).

In Figure 1, note analog post 50 with anti rotation anchoring projections between elements 60.

Claims 1-3, 9-11, 15, 18 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Yanney, Jr. (4,32,423).

Yanney, Jr. discloses an anchored post 17 for preparing dental crown 23 for insertion into a patient's mouth having radial barb projections 19. The Yanney, Jr. device meets the broad limitations of the present claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson et al (5,125,841).

Carlsson et al disclose a circular cross-section for the pin rather than the variety of different geometric cross-sections set forth in the present claims by applicant. One of ordinary skill in the art, however, would have found it obvious to have used other

common geometric configurations for the cross-section of the Carlsson et al pin as a matter of routine design.

Claims 1-11, 18 and 25-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (WO 98/52490) (note US 6,332,77 B1 is relied upon herein as an accurate translation of the PCT application).

In regard to claims 4-8, Sutter discloses a circular cross-section for the pin rather than the variety of different geometric cross-sections set forth in the present claims by applicant. One of ordinary skill in the art, however, would have found it obvious to have used other common geometric configurations for the cross-section of the Sutter pin as a matter of routine design

To the extent that applicant's "analog post" limitation requires an interpretation that the "analog post" is representative of the implant, Sutter discloses such a post 263 (Figures 11-14) having anti-rotation projections 266 extending radially therefrom for fixing the post in the dental mold. Sutter does not appear to explicitly disclose that these projections 266 (illustrated schematically) can be designed as those projections shown at 60 in Figure 1. One of ordinary skill in the art, however, would have readily found that the design of the projections 60 for preventing rotation could obviously be applied to the projections 266 in order to prevent rotation.

#### **Allowable Subject Matter**

Claims 12, 14, 16, 17, 19, 21, 23 and 21 are objected to as being written on a rejected base claim but would be allowable if rewritten in independent form to include all of the limitations of the claims from which they depend.

Claims 30, 32-36 and 38-41 would be allowable if rewritten in independent form to overcome the 35 U.S.C. 112, second paragraph rejection above and to include all of the limitations of the claims from which they depend.


**Action Made Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(703) 308-0770**. Fax (703) 872-9302. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis  
October 3, 2003

  
Ralph A. Lewis  
Primary Examiner  
AU3732